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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,903	03/09/2004	Joetta Renee Palmer	0102417 - 0521924	1634

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FROST BROWN TODD, LLC
2200 PNC CENTER
201 E. FIFTH STREET
CINCINNATI, OH 45202

EXAMINER

JOHNSON III, HENRY M

ART UNIT

PAPER NUMBER

3739

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/796,903	Applicant(s) PALMER ET AL.	
	Examiner Amy T. Lang	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/12/2005, 3/9/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - (i) page 3, lines 22-23 include the phrase "dissector 10 includes and elongate shaft," where "and" should be replaced with "an."
 - (ii) page 5, lines 6-7 include the phrase "in such situations, the locating the distal," which should be replaced with "in such situations, locating the."
 - (iii) page 5, line 33 contains the phrase "aligned with" repeated in the same sentence.
 - (iv) page 6, line 18 includes the phrase "that the after the surgeon," which should be replaced with "that after the surgeon."
 - (v) page 6, line 24 includes the phrase "the geometry of present example," where "the" is missing.

Appropriate correction is required.

Claim Objections

2. Claim 2 is objected to because of the following informalities: Claim 2 states "wherein the diffuse visible energy is diffuse." Since the applicant fails to previously claim "diffuse energy," it is the examiner's position that the phrasing should be replaced with wherein the visible energy is diffuse." Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-8 and 11-21** are rejected under 35 U.S.C. 102(e) as being anticipated by Wagner (US 2004/0204734 A1).

With regards to **claims 1-3 and 8**, Wagner discloses a surgical dissection tool (290) having an elongate shaft (280) (Figure 2, [0007]). A dissector is located at the distal end of the shaft and is shown in Figure 2 as blunt, which clearly overlaps the instant claim ([0008]). The tip of the distal end further comprises a light source (282) for penetrating through skin ([0008]).

With regards to **claim 4**, as shown in Figure 5A, the shaft (280) inherently has a circular cross section at the tip.

With regards to **claims 5-7**, Wagner further discloses the shaft as curved, rigid, or malleable, which clearly overlaps the instant claims ([0009], [0039], [0040]).

With regards to **claims 11 and 12**, the light source (282) is further disclosed as a light emitting diode or white light ([0037], [0044]).

With regards to **claims 13-21**, Wagner discloses a method for dissecting tissue using the surgical dissection tool (290). Tissue is severed using the dissector while light

Art Unit: 3731

emits from the light source so that the position of the dissector tip may be observed through the tissue ([0034], [0042]). Therefore, in order for the device of Wagner to dissect tissue, the device is inherently placed near the tissue to be cut. The tissue is then inherently separated into first and second tissues when the dissection occurs.

Additionally, the first and second tissue would inherently be differentiated by the light source passing through the first or second tissue.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US 2004/0204734 A1).

Wagner discloses a surgical dissection tool wherein a light source is utilized to display the position of the tip of the tool. A non-exhaustive example of the light source

Art Unit: 3731

is disclosed as an incandescent bulb, a light emitting diode, a florescent light source, a vapor lamp, an arc lamp, a plasma light source, and a halogen bulb ([0037]). Therefore, since Wagner is open to light source as long as it penetrates through the desired tissue, it would have been obvious to one of ordinary skill at the time of the invention for the luminous intensity of the light source to be within 300 to 1500 lux.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy T. Lang whose telephone number is 571-272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Application/Control Number: 10/796,903

Page 6

Art Unit: 3731

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

02/06/2007

ATL


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
